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EXAMINER	
BACKER, FIRMIN	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 16

Application Number: 09/729,394
Filing Date: December 04, 2000
Appellant(s): KISSNER ET AL.

GEORGE M. McDONALD
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to Remand from the Board of Appeals and Interferences filed September 29th, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-10 and 12-18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,909,373	Sansome et al	06-1999

5,907,830	Engel et al	05-1999
6,018,718	Walker et al	01-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4, 10, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sansone et al '373.

Sansone et al '373, figure 2, disclose a data center, element 23, for giving rebates to owners of a postage kiosk such that Applicants' computer reads on element 27 and column 3, lines 24 – 27, Applicants' means for determining a rebate reads on element 26 and elements 61 and 62 (figure 5), and Applicants' means for sending the rebate reads on element 28 and column 3, lines 59 – 61.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone et al '373.

Although Sansone et al '373 do not disclose that the rebate can be given in the form of a check, it is considered old and well known for rebates to be provided in the form of a check; e.g., when purchasing items offering rebates, the customer frequently receives his/her rebate via a check. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the meter owner with a check rather than crediting the rebate amount to the owner's credit line, as disclosed by Sansone et al '373, as a matter of design preference.

5. Claim 5, 7, 8, 9, 12, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone et al '373 in view of Walker et al.

Regarding claims 5, 8 and 9:

Although Sansone et al '373 do not specify the rebate in the form of a certificate, Walker et al teach that rebates can be in many forms, one of which is given in the form of a discount coupon (certificate). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to give rebates in the form of a coupon (certificate) as a matter of design preference as the purpose, whether in check form, percentage off of a purchase or a coupon is one of many methods of rewarding a purchaser.

Regarding claim 7:

Although neither Sansone et al '373 nor Walker et al teach sending the certificate to the customer to a facsimile, meter or e-mail address, it is considered old and well known that coupons/certificates and any other communications may be sent to a person via; e.g., a facsimile address.

Regarding claim 12:

Walker et al teach that the amount of a rebate can be the result of calculating a percentage of the customer's purchases (amount spent). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to calculate the rebate disclosed in Sansone et al '373 by utilizing the percentage of postage purchased by a customer.

Regarding claims 17 and 18, they disclosed the same inventive concept as claim 1 and 9, therefore, they are rejected under rationale.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al.

Engel et al discloses cryptographically securing a coupon. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to make the coupon of Walker et al cryptographically secure as this would prevent the fraudulent use of coupons and hence loss of profit for the issuer/redeemer.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone et al '373 in view of Walker et al and Engel et al.

Regarding claims 16 see the art rejection of claims 5 and 6, discussed above.

(11) Response to Argument

A. Appellant argues that the prior art fail to teach "a rebate based on the current postage refill amount" and the this inventive concept is not inherent". Examiner respectfully disagrees with Appellant's characterization of Sansone et al's inventive concept. Sansone teach and inventive concept that provides a postal kiosk that contains a postage meter or franking machine. The kiosk also contains a postage meter secure classifier; and a modem link, which communicates with a data center, that is located at a different location. The secure classifier records every time postal funds are dispensed by the postal meter and classifies the postal transactions of the postage meter into various categories, which are then stored in funds registers memory. The modem link communicates with the secure classifier and the data center, during a postage meter refill, by exchanging funds and information so that proper rebates will be applied to the kiosk owner (*see summary of the invention)*. Sansome et al further teach Account computer uses the information obtained from postage rebate processor and refill computer to **generate account reports that indicate the amount of postage issued by meter together with the rebate that should be applied to meter** (*see column 3 lines 44-49).* Thus an anticipation of the claims under 102 (b) has been establish it is shown that every element or step has been found in the prior art. Furthermore, the rejection is not proper traverse based on the facts. However, prior art such as Mori, (4,932,485) teach a method wherein the amount eligible for rebate of the customer which is stored in the memory means on the basis of the total purchase amount of the customer.

B. As per claims 2, 5, 7-8 and 12-13, which depend on claim 1, Appellants argue that

Examiner fail to provide reason why one having skill in the art would have been motivated to modify the applied reference to arrive at the claimed invention. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the disclosed inventive concepts are well known in the art.

C., E. As per claims 17 and 18, Appellant argue that the claims are not properly rejected since Examiner has not provided any reference teaching or suggestion of the rebate preference element emphasized. Examiner, indicated that claims 17 and 18, disclosed the same inventive concept as claim 1-16, therefore, they are rejected under rationale. This is to indicate that the same reference is applicable to claims 17 and 18.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Firmin Backer
Examiner
Art Unit 3621

September 14, 2004

Conferees
John Hayes

JOHN W. HAYES
PRIMARY EXAMINER

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